P17233.P11

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Attorney Docket No. P17233

In re application of : H. PRANZING et al.

Serial No. : 09/228,658 Group Art Unit: 1731

Filed : January 12, 1999 Examiner: D. Walls

For : PRESS DEVICE AND METHOD OF USING THE SAME

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is an Reply Brief Under 37 CFR 1.193 (b)(1) (in triplicate) in the above-captioned application.

___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.
___ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
X A Request for Oral Hearing (in triplicate).
___ No Additional Fee.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 34	*34	0	x 9=	$	x 18=	$0.00
Indep. Claims: 2	**3	0	x 40=	$	x 80=	$0.00
Oral Hearing Fee			135=	$	+270=	$270.00
Extension Fees for Month				$		$0.00
			Total:	$	Total:	$270.00

*If less than 20, write 20
**If less than 3, write 3
___ Please charge my Deposit Account No. 19-0089 in the amount of $____.
X A Check in the amount of $270.00 to cover the filing fee is included.
X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
X Any additional filing fees required under 37 C.F.R. 1.16.
X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Neil F. Greenblum
Reg. No. 28,394

#15
7/13/01

P17233.A10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : H. PRINZING et al.

Group Art Unit: 1731

Appln No. : 09/228,658

Examiner: D. Walls

Filed : January 12, 1999

For : PRESS DEVICE AND METHOD OF USING THE SAME

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This Reply Brief is in response to the Examiner's Answer dated May 9, 2001, the period for reply extending until July 9, 2001.

In the Examiner's Answer, the Examiner maintains the grounds of rejection advanced in the final rejection and provides arguments in support thereof.

Appellant notes that this Reply Brief is being filed under 37 C.F.R. 1.193(b)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note that they are addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

Appellants wish to clarify their remarks with respect to Issue (B). In particular, Issue (B) should have stated "**Whether Claim 25 is Improperly Rejected Under the Judicially Created Doctrine of Obviousness-Type Double Patenting as being Unpatentable Over Claims 1 - 9 of BENTELE in view of EP '495 and further in view of *Handbook for Pulp & Paper Technologists, 2nd. Ed.* [hereinafter "SMOOK"],**" i.e., the "in view of EP '495" was inadvertently omitted from the statement of the issue.

However, Appellants note that Appellants' arguments are not significantly affected by this inadvertent omission. That is, Appellants note that the improper combination of claims 1 -9 of BENTELE and EP '495 was fully presented in the arguments related to Issue (A), as well as the failure of any proper combination of claims 1 - 9 of BENTELE and EP '495 to render at least independent claim 1 obvious.

Moreover, as previously stated by Appellants, SMOOK fails to teach or suggest any of the subject matter noted above as deficient in claims 1 - 9 of BENTELE. Further, Appellants submit that SMOOK fails to teach or suggest any of the subject matter noted above as deficient in the asserted combination of claims 1 - 9 of BENTELE in view of EP '495, and fails to teach or suggest any motivation or rationale for rendering the asserted combination of claims 1 - 9 of BENTELE and EP '495 proper under 35 U.S.C. § 103(a). As such, Appellants submit that claim 25 is patentably defined over any proper combination of

claims 1 - 9 of BENTELE in view EP '495 and further in view of SMOOK.

Accordingly, Appellants request that the Examiner's final rejection of claim 25 under the judicially created doctrine of obviousness-type double patenting rejection be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over claims 1 - 9 of BENTELE in view of EP '495 in view of SMOOK and for an early allowance of all claims on appeal.

Second Issue

Appellants submit that the Examiner has read the prior art in light of Appellants' disclosure instead of reading the art for what is actually disclosed in the art alone. On pages 3 - 7, section 11 (*Response to Argument)*, the Examiner has noted portions of the applied document EP '495 but has interpreted these disclosures relative to the instant invention instead of in light of the disclosure of the device of BENTELE (or DE '443, which is a patent family member of BENTELE), which is sought to be modified by the Examiner. In particular, the Examiner has noted the disclosure of column 1 of EP '495 that "the shoe press shown affords the possibility of *varying* the *distribution of the pressing force* as desired over the width of the web." (*Examiner's Answer*, page 4, lines 1 - 3). While Applicants acknowledge the above disclosure, Applicants submit that Examiner's assertions that this disclosure suggests "means to affect a pressure differential between pressures generated by the support elements in both the shoe press roll and the counter roll," (*Examiner's Answer*, page 4, lines 4 and 5), is not supported by the art of record.

Specifically, Applicants submit that the disclosure of EP '495 is directed to a device in which a substantially same force is applied by support elements 13 and 23, although valve 28 is provided to compensate for the weight of the roll jacket 21, which would otherwise increase the applied force against the lower roll. However, contrary to the Examiner's assertions, Applicants submit that it would not have been apparent to one ordinarily skilled in the art, simply because EP '495 discloses that the shoe press affords the *possibility* of varying the distribution of pressing force over the web width, to utilize the teaching of EP '495 as a basis for modifying a pressure differential in a system such as BENTELE (or DE '443).

In this regard, Appellants again note that EP '495 does not teach or suggest applying a differential pressure to the support elements, and certainly fails to provide any teaching or suggestion of varying a pressing force distribution over a width of the web by varying differential pressure. Still further, as the above-noted features are neither taught nor suggested by EP '495, Appellants submit that EP '495 certainly fails to teach or suggest any manner in which differential pressure could be adjusted. Further, Appellants note that, because BENTELE (or DE '443) also fails to provide any teaching or suggestion of adjusting a pressure differential between internal pressures generated by the at least one second support element acting on the roll jacket, or any teaching or suggestion of any structure or apparatus which could perform the above-noted change in differential pressure, it would not have been obvious to ordinarily skilled in the art to modify BENTELE (or DE '443) in light of the

disclosure of EP '495 in the manner asserted by the Examiner.

Accordingly, Appellants submit that, as neither applied document teaches or suggests varying differential pressure in the manner recited in at least the independent claims, no proper combination of BENTELE (or DE '443) and EP '495 can render unpatentable the combination of features recited in the pending claims.

Moreover, even assuming, *arguendo*, that the disclosure of EP '495 related to varying the pressing force distribution over the width the web were sufficient to provide some teaching related to varying a pressure differential in BENTELE (or DE '443) (which Appellants submit it is not), Appellants submit that, as noted by the Examiner, EP '495 only discloses a *possibility* of varying the pressing force distribution, and thus, does not provide any teaching or suggestion as to how such a pressing force distribution would be achieved, particularly with respect to a system such as BENTELE (or DE '443). Moreover, as noted above, as BENTELE (or DE '443) certainly does not provide any teaching or suggestion with respect to varying differential pressure in the manner recited in at least the independent claims, Appellants submit that any proper combination of the applied art would have been wholly deficient to render the instant invention obvious. Moreover, the applied art is wholly deficient as to any disclosure related to *how* the asserted variation of the differential pressure of BENTELE (or DE '443) would have been obtained in view of the applied art.

Still further, Appellants submit that, as the above-noted combination of BENTELE (or DE '443) and EP '495 (which has been shown to be, not only improper, but inadequate

to render the instant invention unpatentable under 35 U.S.C. § 103(a)), provides the basis for each ground of rejection maintained by the Examiner, all rejections over the art of record are improper and should be reversed and remanded to the Examiner for allowance.

Moreover, Appellants again note that the applied secondary document of SMOOK fails to teach or suggest any of the subject matter noted above as deficient in the asserted combination of BENTELE (or DE '443) in view of EP '495, and fails to teach or suggest any motivation or rationale for rendering the asserted combination of BENTELE (or DE '443) and EP '495 proper under 35 U.S.C. § 103(a). Thus, Appellants submit that any proper combination of BENTELE (or DE '443) in view EP '495 fails to render the instant invention unpatentable.

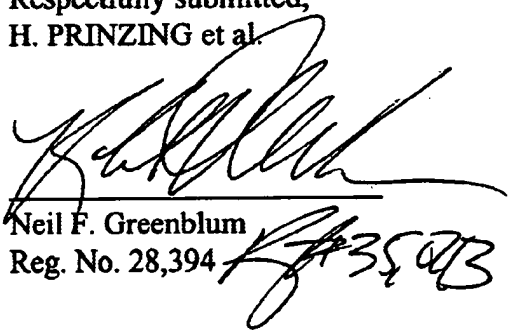
For the foregoing reasons, Appellant submits that the instant rejections over BENTELE (or DE '443) in view of EP '495; over BENTELE (or DE '443) in view of EP '495 and further in view of SMOOK; over claims 1 - 9 of BENTELE in view of EP '495; and over claims 1 - 9 of BENTELE in view of EP '495 and further in view of SMOOK are improper for failure to render the combination of features unpatentable and for failure to provide the necessary motivation or rationale for modification under 35 U.S.C. § 103(a). Accordingly, Appellants submit that, as the asserted combinations of documents are improper, the rejections of the claims based upon these improper combinations are likewise improper and should be reversed.

CONCLUSION

For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellant further requests that the application be returned to the Examining Group for prompt allowance.

This Reply Brief is submitted herewith in triplicate for the convenience of the Board. Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellant respectfully requests an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
H. PRINZING et al.



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July 9, 2001
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